

### REMARKS

Claims 1-23 are currently pending. Applicant notes with appreciation Examiner's preliminary allowance of claims 2-6, 8-18, and 21-23.

Applicant notes that the specification has been amended to reflect the status of the parent application.

Claims 1, 7, 19 and 20 are rejected under 35 USC 103(a) as being unpatentable over Kuroda et al. (US Patent No. 6,640,433 B1) in view of McLean II et al. (US Patent No. 5,747,120) in view of Daniels et al (US Patent No. 6,185,992 B1). The Examiner has indicated that Kuroda teaches a "method to test." Applicant respectfully disagrees. More specifically, Kuroda teaches a method for forming a micro-pattern and the probe 104 is used for cutting through and etching the thin film 101. Thus, Kuroda is not directed at "measuring a characteristic related to the first film and the second film contacting using at least one measurement circuit to perform at least one measurement after the first film and the second film contact each other at a controlled force." This point is further demonstrated by the Examiner's conclusion that Kuroda "does not refer to a second film on the probe . . ." Thus, Kuroda does not teach, disclose, nor suggest measuring a characteristic between a first film and a second film contacting as set forth in independent claim 1.

The Examiner asserts that it "would have been obvious to employ a second film on the probe because McLean, II et al. teach use of a film on a probe to increase useful life of an AFM tip." Applicant respectfully disagrees. McLean II teaches coating the surface of an AFM tip to increase its useful life. Thus, combining a reference that teaches use of a probe to cut the surface of a single sample (Kuroda) with a reference that teaches coating the tip of a probe to increase its useful life (McLean II) does not teach, suggest, or make obvious Applicant's claimed invention of "measuring a characteristic related to the first film and the second film contacting using at least one measurement circuit to perform at least one measurement after the first film and the second film contact each other at a controlled force."

Finally, the Examiner asserts that Daniels teaches use of a chuck. Use of chuck, even if taken in combination with Kuroda and McLean II does not teach, suggest, or make obvious "measuring a characteristic related to the first film and the second film contacting using at least

one measurement circuit to perform at least one measurement after the first film and the second film contact each other at a controlled force" as set forth in Applicant's claimed invention."

Accordingly, the combination of Kuroda with McLean II taken in view of Daniels does not teach, disclose, nor suggest "measuring a characteristic related to the first film and the second film contacting using at least one measurement circuit to perform at least one measurement after the first film and the second film contact each other at a controlled force" as set forth in Applicant's independent claim 1. Thus, Applicant requests withdrawal of Examiner's rejection of independent claim 1 and full allowance of same.

Claims 7, 19, and 20 depend from and further limit, in a patentable sense, independent claim 1 and, hence, are also in condition for allowance. Thus, Applicant request withdrawal of Examiner's rejection of claims 7, 19, and 20 and full allowance of same.

#### **Conclusion**

All objections and rejections having been addressed, and in view of the foregoing, the claims are believed to be in form for allowance, and such action is hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he or she is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted

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